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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/443,401	11/19/1999	SAID ZAMANI-KORD	10991745-1	7179

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FORT COLLINS, CO 80527-2400

EXAMINER

NGUYEN, KIMBERLY T

ART UNIT	PAPER NUMBER
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1774

DATE MAILED: 08/28/2002

11

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/443,401

Applicant(s)

ZAMANI-KORD ET AL.

Examiner

Kimberly T. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 April 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-14 and 32-37 is/are pending in the application.
- 4a) Of the above claim(s) 15-31 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 and 32-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

This action is in response to the request to withdraw the finality of the previous office action. Due to Applicants' remarks, the finality of the previous office action of August 15, 2002 is withdrawn.

### ***Specification***

Due to Applicants' amendment of the specification, the previous objection to Figure 8 is withdrawn.

### ***Claim Rejections - 35 USC § 112***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office Action.

In claim 1, it is unclear how the indicia is "defined by" a fluorescent material because it is not clear if the indicia *comprises* the fluorescent material and is thus, "defined by" the fluorescent material or that the indicia has a fluorescent material bordering which "defines" the position and/or shape of the indicia. For purposes of examining, Examiner understands the terms "defined by" as the indicia *comprising* a fluorescent material.

### ***Claim Rejections - 35 USC § 102***

**Claims 1-6, 9, and 11-13** are rejected under 35 U.S.C. 102(b) as being anticipated by Chatwin et al., U.S. Pat. No. 5,492,370 as previously stated in the Office Action submitted on December 12, 2001.

**Claim 32** is rejected under 35 U.S.C. 102(b) as being anticipated by Chatwin et al., U.S. Pat. No. 5,492,370.

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Chatwin is relied upon as above for claim 1. Chatwin further shows that the substrate is planar and the first surface is parallel to the second surface (Figure 1 and column 12, lines 61-67).

**Claims 33-37** are rejected under 35 U.S.C. 102(b) as being anticipated by Chatwin et al., U.S. Pat. No. 5,492,370.

Chatwin shows a machine-readable decorative article comprising a polyester planar substrate (column 6, lines 18-27 and Figure 1 and column 12, lines 61-67), an opaque aluminum metallic coating (metal layer) (column 10, lines 34-38) or zirconium oxide film (column 10, lines 60-65) provided upon the substrate, an indicia-receptive coating provided upon the metallic coating or zirconium oxide film (column 4, lines 35-54), and a layer of invisible fluorescent indicia (column 8, lines 19-29). Chatwin shows that the indicia receptive coating may be a black coating (black background, absorptive layer) (column 14, lines 24-25). Chatwin shows that the decorative article can be incorporated into bank note threads (column 12, lines 61-67) and that *both* sides (first surface and second surface) of the thread (planar substrate with *two* sides) may be embossed, metallised, and printed (column 12, lines 66-67). Further, Chatwin shows that portions of the polypropylene substrate film is printed with security indicia (column 13, lines 34-41).

### ***Claim Rejections - 35 USC § 103***

Due to Applicants' remarks, the previous rejection of claim 10 is withdrawn.

**Claims 1, 7-8, and 14** are rejected under 35 U.S.C. 103(a) as being unpatentable over Chatwin et al., U.S. Pat. No. 5,492,370 in view of Hiraishi et al., U.S. Pat. No. 4,780,391 as previously stated in the Office Action submitted on December 12, 2001.

**Claims 1 and 10** is rejected under 35 U.S.C. 103(a) as being unpatentable over Chatwin et al., U.S. Pat. No. 5,492,370 in view of Curatolo, U.S. Pat. No. 6,165,609 as previously stated in the Office Action submitted on December 12, 2001.

Chatwin shows a machine-readable decorative article comprising a polyester substrate (column 6, lines 18-27), an opaque aluminum metallic coating (metal foil layer) (column 10, lines 34-38) or zirconium oxide film (column 10, lines 60-65) provided upon the substrate, an indicia-receptive coating provided upon the metallic coating or zirconium oxide film (column 4, lines 35-54), and a layer of invisible fluorescent indicia (column 8, lines 19-29). Chatwin shows that the decorative article can be incorporated into bank note threads (column 12, lines 61-67) and that both sides of the thread (substrate) may be embossed, metallised, and printed (column 12, lines 66-67). Further, Chatwin shows that portions of the polypropylene substrate film is printed with security indicia (column 13, lines 34-41). Chatwin does not show the fluorescent material as in instant claim 10.

Curatolo shows security coatings for labels comprising a substrate layer and a security coating on at least one side of the substrate comprising an invisible fluorescent material which fluoresces energy at a wavelength from about 390nm to about 700nm (column 3, lines 43-54). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the invisible fluorescent material in Curatolo as the invisible fluorescent ink in Chatwin because such a fluorescent material which fluoresces between 390nm and 700nm is known in the art to be effectively used in security and anti-counterfeiting documents since they are invisible to the naked human eye and require excitation radiation to view them.

**Claims 33-37** are rejected under 35 U.S.C. 103(a) as being unpatentable over Chatwin et al., U.S. Pat. No. 5,492,370 in view of Schneider et al., U.S. Pat. No. 5,876,068.

Chatwin shows a machine-readable decorative article comprising a polyester planar thread substrate (column 6, lines 18-27 and Figure 1 and column 12, lines 61-67), an opaque aluminum metallic coating (metal layer) (column 10, lines 34-38) or zirconium oxide film (column 10, lines 60-65) provided upon the substrate, an indicia-receptive coating provided upon the metallic coating or zirconium oxide film (column 4, lines 35-54), and a layer of invisible fluorescent indicia (column 8, lines 19-29). Chatwin shows that the indicia receptive coating may be a black coating (black background, absorptive layer) (column 14, lines 24-25). Chatwin shows that the decorative article can be incorporated into bank note threads (column 12, lines 61-67) and that *both* sides (first surface and second surface) of the thread (planar substrate with *two* sides) may be embossed, metallised, and printed (column 12, lines 66-67). Further, Chatwin shows that portions of the polypropylene substrate film is printed with security indicia (column 13, lines 34-41). Schneider shows a security thread or *strip* (Abstract). It would have been obvious to one of ordinary skill in the art at the time the invention was made that the thread substrate in Chatwin is planar and has 2 surfaces as in instant claims 33-37 because Chatwin shows this in Figures 1, 4, and 6 and because it is known, as shown in Schneider, that threads, in the art of security documents, are planar and are also referred to as threads or strips.

#### ***Response to Arguments***

Applicants' argument filed April 22, 2002 have been fully considered but they are not persuasive.

On pages 5-6, Applicants argue that Chatwin does not show each element as set forth in Claim 1, namely the first and second indicia defined by a fluorescent material and a means for preventing interference between a fluorescing signal by the first and second indicia. Examiner disagrees. Chatwin shows in column 12, lines 66-67 that *both* sides of a thread substrate can be embossed, metallised, and printed such that the layers 4, 5, 6, and 7 in Figure 1 are duplicated on the other side of the substrate 2. Thus, Chatwin shows that there can be two layers of a fluorescent indicia (first and second information bearing indicia defined by a fluorescent material) and a means for preventing interference is shown by the opaque aluminum metallic coating.

On pages 6-7, Applicants argue that there is no suggestion to combine Chatwin and Hiraishi in such a way to provide the instant invention. Applicants argue that the previous rejection is the product of prohibited hindsight reconstruction and that there is no teaching or suggestion in either reference to show the substrate as in instant claims 7 and 8. Examiner disagrees. Chatwin shows that the substrate includes a structure for *generating a viewable optically variable effect* and can include a plastic film, papers, and woven or non-woven plastic fibers. To provide for such an optically variable effect, one of ordinary skill in the art would find obvious to use as a support, a metal foil layer and/or a paper layer and/or a composite sheet made from both metals and paper as shown in Hiraishi to achieve certain patterns, transparencies, or opacities (column 6, lines 42-44).

### ***Conclusion***

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kimberly T. Nguyen whose telephone number is (703) 308-8176. The examiner can normally be reached on Monday to Friday, except on every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia H. Kelly can be reached on (703) 308-0449. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

CYNTHIA H. KELLY  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1700

